

Application No.: 09/851,367

Atty. Dkt.: ZL327-01008

Page 11 of 21

REMARKS

Reconsideration of the pending application is respectfully requested. Claims 1-15 and 21-38 remain pending in the present application.

35 U.S.C. 102 Rejections

The Examiner has rejected Claims 1-2, 25, and 28 under 35 U.S.C. 102(b) as being anticipated by Nicholl (U.S. Pat. 4,177,500). Applicant's Attorney respectfully traverses the Examiner on this grounds of rejection.

The presently claimed invention is a fully recessed self contained emergency lighting unit. What is claimed in Claim 1 is a recessed unit equipment luminaire comprising; a housing, a battery, a charging/emergency switching circuit electrically connected to the battery, a directional lamp mounted within the housing and being electrically connected to the battery through the charging/emergency switching circuit, and a cover having an opening to allow light from the directional lamp to be directed therethrough.

Claim 25 claims a unit equipment housing and battery box assembly comprising; a shallow rectangular shaped housing having a bottom wall, back wall, and an open front, the bottom wall has an opening along the intersection of the bottom wall and back wall; a battery box having a front wall, back wall, side walls extending between the front wall and back wall, a closed bottom, an open top, and a flange extending around the upper edge of the front and side walls; the battery box is received within the housing bottom wall opening such that the bottom of the battery box flange contacts the inner surface of the housing bottom wall along the periphery of the bottom wall.

Application No.: 09/851,367

Atty. Dkt.: ZL327-01008

Page 12 of 21

Claim 28 claims a fully recessed unit equipment luminaire comprising; at least one battery, a battery box having walls for containing the battery and an opening for receiving the battery, a housing having walls defining a chamber and an open front, one of the walls having an opening, the housing and battery box are attached such that the housing wall opening is in alignment with the battery box opening; a charger chassis having a charger/emergency switching circuit mounted thereto, the charger chassis is received within and attached to the housing over the battery box opening such that the charger chassis provides a barrier between the housing chamber and battery; a directional lamp electrically connected to the battery through the charger/emergency switching circuit, the lamp also is received within the housing; and a cover closing the housing front, the cover has a light exit aperture positioned to allow light from the lamp to illuminate an area external to the luminaire.

Nicholl teaches a power failure light for monitoring a power line and for emergency illumination upon interruption of such power. The power failure light includes a housing, a light bulb and prongs mounted through the housing for external illumination, a rechargeable battery, and a switching circuit. The housing holds the rechargeable battery and switching circuit. As set forth in Nicholl.

The housing 2 is formed of high impact plastic and conveniently includes a transparent lens member 45. The lens member 45 may include frosted sides 46 for general dispersion of light and a beam forming end member 47. Alternatively, the housing may include a silvered conical or parabolic reflector member (not shown) mounted in surrounding relations to the light bulb 3 for forming a light beam therefrom. (Nicholl, col.2, lines 26-36).

To anticipate a claim, the reference must teach every element of the claim. MPEP 2131. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil*

Application No.: 09/851,367

Atty. Dkt.: ZL327-01008

Page 13 of 21

*Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The primary difference between this invention and the Nicholl reference is that this invention claims a directional lamp while Nicholl teaches a "light bulb" for general light dispersion. A directional lamp is a projection type multifaceted pressed glass reflector lamp. A pressed reflector lamp is an incandescent filament or electric-discharge lamp in which the outer bulb is formed of two pressed parts that are fused or sealed together; namely, a reflectorized bowl and a cover, which can be clear or patterned for optical control. THE IESNA LIGHTING HANDBOOK G-26 (Mark S. Rea ed., Pub. Dept. IESNA 9<sup>th</sup> ed. 2000). The "light bulb" in Nicholl is a standard non-directional light bulb that does not include any of the structure elements of the directional lamp as indicated above.

Nicholl also teaches that the housing may include a silvered conical or parabolic reflector member mounted in surrounding relations to the light bulb for forming a light beam. The structure of the Nicholl reference is entirely different than the structure claimed in this invention. The lamp taught in Nicholl is non-directional and the directional control taught in Nicholl is accomplished with a conical or parabolic reflector. This invention claims a semi-frustoconical shaped reflector assembly oriented with the wide end proximate to the directional lamp which is positioned to intersect a portion of the directed conical beam. The reflector taught in Nicholl is conical with the narrow end proximate to a non-directional lamp.

In addition, this invention is a recessed unit in contrast with the non-recessed unit in the Nicholl reference. Claim 1 of this invention is directed toward a recessed unit equipment

Application No.: 09/851,367

Atty. Dkt.: Z1327-01008

Page 14 of 21

luminaire. The Nicholl housing unit is plugged into a power receptacle. (Nicholl, Claim 1). It may be unplugged and employed as a rechargeable flashlight. (Nicholl, col. 5, lines 52-54). This non-recessed light unit protrudes from the wall socket the length of the housing unit and lens member into the living space of the room or corridor where it is located. (See Nicholl illustrations). Exposed unit equipment luminaires are not always compatible with the interior design of space. Additionally, such exposed luminaires are subject to both accidental abuse and intentional vandalism. Hence, the recessed luminaire is much more adapted to maintain compliance with NFPA standards.

Thus, the single relied upon reference provided by the Examiner is directed towards a non-directional lamp unit in a non-recessed housing. None of the disclosure within Nicholl is directed towards a directional lamp that is within a fully recessed self contained emergency lighting unit as in Claim 1 of this invention.

Claim 25 of this invention is an independent claim requiring a unit equipment housing and a battery box assembly. There is no disclosure or teaching in the Nicholl patent of a battery box assembly as claimed in Claim 25 of this invention. The battery box claimed in Claim 25 holds only the battery and has an open top and a flange to hold it within the unit equipment housing. No such combination is taught in Nicholl.

Claim 28, as amended, of this invention is an independent claim requiring a fully recessed unit with at least one battery box and a directional lamp as stated above. As previously stated, the Nicholl reference does not teach these elements of the claim.

As can be appreciated, since the Nicholl patent does not disclose a directional lamp; a fully recessed unit; or a battery box as presently claimed, reliance upon the Nicholl reference as

Application No.: 09/851,367

Atty. Dkt: ZL327-01008

Page 15 of 21

an anticipatory reference of the pending claims is inappropriate since each and every element is not directly taught in the relied upon reference.

As the Examiner is aware, in order to be a proper anticipatory reference, and as indicated above, each and every element of the claim limitations must be clearly present in the cited reference. There is no disclosure within the Nicholl patent disclosing a directional lamp, a fully recessed unit or a separate battery box and other material as is presently claimed. As such, reliance upon the Nicholl patent as a proper anticipatory reference is inappropriate as each of the elements claimed in the rejected claims are not found therein. Additionally, Claim 2 is dependent upon Claim 1 and therefore includes all of the limitations of Claim 1. Applicant's Attorney therefore respectfully requests that the Examiner remove said rejections.

The Examiner has rejected Claims 10-13 and 15-19 under 35 U.S.C. 102(b) as being anticipated by Compton (U.S. Pat. 4,231,080). Claims 16-19 have been canceled in order to expedite prosecution of the present case. Applicant's Attorney respectfully traverses the Examiner on this ground of rejection for Claims 10-13 and 15.

Claim 10 now claims a luminaire for illuminating a conical shaped area comprising; a housing, a directional lamp mounted within the housing. The directional lamp is aimed at the conical shaped area and has a cover having an opening to allow light from the directional lamp to be directed toward the conical shaped area. The luminaire also comprises a reflector assembly mounted within the housing along the light path between the directional lamp and cover opening; the reflector assembly being substantially semi-frustoconical in shape oriented with a wide end proximate to the directional lamp and having a reflective surface which redirects a portion of the light emitted from the directional lamp toward the conical shaped area.

Application No.: 09/851,367

Atty. Dkt.: ZL327-01008

Page 16 of 21

Compton conversely teaches a bollard light with an optical louver luminaire

having at least three stacked reflector members.

"When used with a clear-envelope lamp, the luminaire includes a first reflector member 70 which is the frusto-conical member formed by the single continuous straight edge in FIG. 2. When a frosted or phosphor coated lamp is used, then the first reflector member includes a first frusto-conical zone 72 (which is part of the first reflector member already shown), and a second curved surface zone 71 which ends at a flat terminal plate 73 at its upper end. The second zone has a lesser included conical angle than the first zone. It provides a more appropriate distribution of doubly reflected light from coated and frosted lamps.

A second reflector member 75 is next above the first reflector member, and a third reflector member 76 is next above the second reflector member." Compton, col. 3, lines 37-51.

As in the Nicholl reference, Compton does not teach a recess emergency luminair having a directional lamp as presently claimed in this Application. The optical louver luminaire in Compton consists of at least three reflector members which are frusto-conical and surround a non-directional lamp. If a directional lamp were used in the Compton bollard lamp, it would render the reference inoperable as described therein. This is in direct contrast with Claim 10 in this invention where a directional lamp is held by the reflector assembly at a fixed orientation to aim the directional lamp generally toward the path of egress creating a conical path. Claim 10 also claims a housing and cover, neither of which are taught in the Compton reference.

Thus, this relied upon reference provided by the Examiner is directed towards a simple bollard lighting unit. There is no disclosure in the Compton patent of an emergency recessed directional light illuminating a conical shaped area, a housing, or a cover. Therefore, the Compton reference does not teach every element of the claim.

Application No.: 09/851,367

Atty. Dkt.: ZL327-01008

Page 17 of 21

In order to be a proper anticipatory reference, and as indicated above, each and every element of the claim limitations must be clearly present in the cited reference. As previously shown, such is not the case here. Reliance upon the Compton patent as a proper anticipatory reference is inappropriate as each of the elements claimed in the rejected claims are not found therein. Applicant's Attorney therefore respectfully requests that the Examiner remove said rejection. In addition, Claims 11-13 and 15 depend from Claim 10 and therefore include all of the limitations of the independent Claim. Since Claim 10 is believed to be in condition for allowance, Applicant's Attorney respectfully requests this ground of rejection withdrawn.

The Examiner has rejected Claim 27 under 35 U.S.C. 102(b) as being anticipated by Gromotka (U.S. Pat 6,164,802). Applicant's Attorney respectfully traverses the Examiner on this ground of rejection.

Claim 27 of this invention claims a housing for mounting behind the plane of a wall or ceiling. This housing comprises of: a front portion which lies substantially in the plane of the wall or ceiling; at least one side wall having a front edge lying along the front portion, the side wall has a thickness gauge formed on the outside surface thereof, the thickness gauge indicates the distance from the front edge; and a plurality of break-away tabs located around the periphery of the front portion, these break-away tabs extend outward along the plane of the front portion.

Gromotka teaches a lighting fixture which includes a first open end, a second end, a movable dividing plate positioned between the first and second ends, and a release mechanism.

(See Gromotka abstract).

Then, referring to FIG. 9, trim body 400 is pushed into housing 110. As trim body 400 is pushed into housing 110, the wireform springs 135 are compressed. At the point in which the springs 135 are parallel to the groove 150, the compression on the springs is the highest. Once the trim body passes this

Application No.: 09/851,367

Atty. Dkt.: ZL327-01008

Page 18 of 21

point, expansion of the springs pulls the trim body into the housing. Referring to FIG. 10, when the trim body 400 is seated against the ceiling, the compression in the springs 135 exerts an upward force on the trim body. This force keeps the trim body seated in the housing 110 and against the ceiling. (Gromotka col. 3, lines 47-59)

The invention claimed in this application claims a plurality of break-away tabs located around the periphery of the front portion, these break-away tabs extend outward along the plane of the front portion. The Gromotka reference has no break away tabs. This invention has thickness gage formed on the outside of the housing to aid in the recessed installation. The Gromotka reference has no such gage.

Since each of the elements claimed in Claim 27 are not found in the Gromotka reference, Applicant's Attorney therefore respectfully requests that the Examiner remove said rejection.

### 35 U.S.C. 103 Rejections

The Examiner has rejected Claims 3-13, 15-19, 21, 24, 26, 29-38 under 35 U.S.C. 103(a) as being unpatentable over Nicholl in view of Enka et al (U.S. patent 4,614,996). The Examiner has stated that Nicholl discloses the claimed invention except for a semi-frustoconical in shape reflector assembly and that Enaka teaches that it is known to provide Nicholl with the semi-frustoconical reflector assembly. Enka teaches:

"a ceiling illumination apparatus of a room in which: a wall of the ceiling has a large number of recessed wall portions formed therein in a honeycombed manner, thereby forming projected wall portions between corners of the adjacent recessed wall portions; a plurality of illumination means for electrically illuminating corresponding recessed wall portions are provided through supporting means to the ceiling; and ceiling appliances including smoke sensors, and inlets and outlets of an air conditioner, wherein each supporting means comprises a pipe being connected at one end thereof to a corresponding projected wall portion and at the other end thereof to a corresponding illumination means so



Application No.: 09/851,367

Atty. Dkt.: ZL327-01008

Page 19 of 21

that the corresponding illumination means is positioned just below a corresponding recessed wall portion; and wherein the ceiling appliances are mounted on the projected wall portions." Enka, col. 1, lines 24-41.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. In re Vaech, 947 F.2d 488, 20USPQ2d 1438 (Fed. Cir. 1991); MPEP 2142.

The Enka reference does not teach or even suggest the use of an emergency recessed equipment luminaire with a directional lamp. As previously discussed, the Nicholl reference does not suggest the use of a directional lamp. In Claim 1 of this invention a directional lamp is affirmatively claimed. Claims 11-13, 15, 21, and 24 each have the limitation a directional lamp.

Claim 26 is an independent claim that claims a unit equipment housing assembly, battery box, and a chassis. The structural elements of the items claimed herein are quite specific, as can be seen in Claim 26 in the Claims section of this response. An example of the limitation of this claim is as follows:

"a battery box having a front wall, a back wall, side walls extending between said front wall and said back wall, and an open top, a flange extending around the upper edge of the front and side walls, and a wedge shaped protuberance extending outward..." (Application, Claim 26)

Application No.: 09/851,367

Atty. Dkt.: ZL327-01008

Page 20 of 21

As the Examiner can clearly see, there is no teaching or suggestion in the references of all of the limitations of this claim.

Claim 29 is an independent claim which includes a directional lamp, Claims 30-33 depend from Claim 29 and therefore have the limitations of Claim 29. Claim 34 has been amended to include a directional lamp and Claims 35-38 depend from 34 and therefore have the limitations of Claim 34.

None of the references relied upon by the Examiner teach or suggest the structure as presently claimed in this invention, alone or in combination, as noted above. Specifically, none of the references teach the use of a directional lamp or the structure being fully recessed into an existing wall or ceiling. Applicant's Attorney therefore respectfully requests that the Examiner remove said rejections.

The Examiner has rejected Claims 14, 20, 22, and 23 under 35 U.S.C. 103(a) as being unpatentable over Nicholl in view of Enka as applied to Claims 10, 21 and 16 above, and further in view of Compton. Examiner suggests that Nicholl in view of Enaka discloses the claimed invention except for a louver lens and that Compton discloses or teaches the lens.

Again, none of the three references teach or suggest the use of a directional lamp nor does the specific structure set forth therein disclose or even remotely suggest, alone or in combination, this invention. Applicant's Attorney therefore feels that such rejections are inappropriate as no suggestion for modification for this claimed structure has been provided by the Examiner. Applicant's Attorney respectfully requests that the Examiner remove said rejections.

Application No.: 09/851,367  
Att. Dkt.: ZL327-01008  
Page 21 of 21

### Objection of Claims

Claim 28 was objected to as being ambiguous and the specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. Claims 10, 13 and 28 have been amended to resolve these objections. Also, Claim 34 was amended to resolve a rejection as previously discussed. Each of the objections of the claims have been addressed in the claims.

### Conclusion

Applicant's Attorney asserts that the instant application is in condition for allowance. Applicant's Attorney therefore respectfully requests that the Examiner allow the pending claims. However, if the Examiner believes there are other unresolved issues in this case, Applicant's Attorney of record would appreciate a call at (502) 584-1135.

Respectfully submitted,

MIDDLETON REUTLINGER



Steve A. Witters, Reg. No. 53,923  
2500 Brown & Williamson Tower  
Louisville, KY 40202  
(502) 584-1135 phone  
(502) 561-0442 fax  
[switters@middreut.com](mailto:switters@middreut.com)

OFFICIAL

\*\*\*\*\*

FAX RECEIVED

AUG 8 2003

TECHNOLOGY CENTER 2800